

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE APPLICATION OF: William T. Ball
SERIAL NO.: 10/721,694
FOR: CAP FOR SEALING A BATHTUB OVERFLOW
PORT FOR TESTING PURPOSES
FILED: November 25, 2003
GROUP/A.U.: 3751
Confirmation No.: 6303
EXAMINER: Kathleen J. Prunner

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BOARD OF PATENT APPEALS
AND INTERFERENCES

APPEAL BRIEF

Dear Sir:

This is an appeal from the final rejection of claims 1 and 2 dated July 23, 2004.

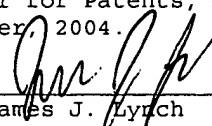
I. Real Party In Interest:

The real party in interest of the instant appeal is WCM Industries, Inc. having offices at 2121 Waynoka Road, Colorado Springs, Colorado 80915.

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CERTIFICATE OF MAILING (37 C.F.R. § 1.8(A))

I hereby certify that this document and the documents referred to as enclose therein are being deposited with the United States Postal Service as First Class mail addressed to: Box BPAI, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 21 day of December, 2004.


James J. Lynch

II. Related Appeals and Interferences:

U.S. Serial No. 10/674,739, filed September 30, 2003, entitled CAP FOR SEALING A BATHTUB OVERFLOW PORT FOR TESTING PURPOSES is a continuation of U.S. Serial No. 10/247,247 filed September 19, 2002. The current application receives priority from this parent application.

III. Status of the Claims:

Presently claims 1-2 are pending in this application and appear as Appendix A of this brief.

IV. Status of Amendments:

An amendment after final was submitted on September 20, 2004, and has been entered for the purpose of appeal.

V. Summary of Claimed Subject Matter:

The present invention is an overflow system for a bathtub 18 having a bottom 26, adjacent side walls 22, and end walls 24. (Pg. 3, lines 19-23). In the bottom 26 is a drain port 28 and in an end wall 24 is an overflow port 30. (P. 3, lines 24-26). Additionally, the system has a drain pipe 32 that is an inverted L-shape including a horizontal leg extending through the overflow port and a vertical leg 34 that extends downwardly for connection with a fluid drain system 38 and additionally is in communication with the drain port 28. (P. 3, lines 26-33). The horizontal leg of the drain pipe has threads 31 on its outer surface that receive a cap 52. (P. 4, lines 7-10). The cap 52 threadably engages the threads on the horizontal leg. (Id.) The cap is specially designed to have an opening in its circular planar end and a thin sealing membrane 66 secured to the cap 52 and extending

over the opening in the circular planar end. (P. 4, lines 14-18). The thin sealing membrane 66 is flexible and pliable.

VI. Grounds of Rejection to be Reviewed on Appeal

Claims 1 and 2 have been rejected. Claim 1 has been rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Claim 2 has been rejected under 35 U.S.C. §102(b) as being anticipated by Delanoy (U.S. Patent No. 1,213,466). Claim 1 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Ball (U.S. Patent No. 5,890,241) in view of Lewis (U.S. Patent Publication No. 2002/0032926). Claims 1 and 2 are hereby identified as the claims appealed.

VII. Argument:

A. Description of the Prior Art

U.S. Patent No. 1,213,466 to Delanoy.

Delanoy provides for a trap 2 that is connected to a drainage pipe for draining a bathtub. The trap 2 has interior threads 3 at a first end that receive the exterior threads of a bushing 6. The bushing 6 receives a pipe 5 and has a plate element 10 on its bottom. Delanoy does not show a cap assembly that is threadably mounted on the first end of a pipe. Instead, the bushing 6 frictionally engages pipe 5 and threadably engages the interior threads of the end of trap 2. Consequently, the bushing 6 is within the first end of trap 2 and therefore is not threadably mounted on the first end of trap 2.

U.S. Patent No. 5,890,241 to Ball.

The Ball device provides a pipe 34 that is in communication with an overflow port 30. A plate 52 is formed on the upper end of pipe 34 and has a center opening 54. A

diaphragm or membrane 64 comprised of flexible rubber or the like is imposed over the overflow port 30 and engages the interface 62 of sleeve 60 of the plate 52. A plate 70 is superimposed over the diaphragm 64 and has a center opening 72. A cap 82 can then be placed over the top of the diaphragm 64 and plate 52 after a water testing procedure. The diaphragm may be cut into during a water testing procedure and then covered by the cap. The Ball reference does not provide the pipe 34 having a horizontal leg that extends into and through the overflow port and having exterior threads such that a cap can be threadably mounted onto the horizontal leg after testing. Instead, the cap 82 is secured to the pipe 34 by the use of a screw 80.

U.S. Publication No. 2002/0032926 to Lewis

The Lewis disclosure provides an overflow elbow 20 that has a threaded member 23 protruding therefrom. The threads extend through the overflow port and are engaged by the interior threads 22 of capture nut 21. Capture nut 21 additionally has an opening such that during a testing procedure a plug 8 is inserted through the opening and into the opening that defines an overflow port. When installed, the bathtub end wall 30 is placed between the nut element 21 and a gasket 9 that fits around the threaded element 23. The Lewis reference does not provide for a thin membrane.

B. Argument In Support of Reversal

1. Matter added in the previous office action provides an inherent property of the invention and it does not constitute new matter under 35 U.S.C. § 112

The Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner asserted that the addition of the word "flexible" in claim 1, to describe the sealing membrane, constituted new matter which was not present in the specification. "By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant, necessarily discloses that that function, theory or advantage even though he says nothing concerning it." In re Nathan, 328 F.2d 1005, 140 USPQ 601 (CCPA 1964). The court went on to find that an added claim limitation was an inherent characteristic of the subject matter identified, and consequently did not provide new matter. See id. The term "membrane" has an ordinary meaning of: "a thin, pliable sheet or layer of animal or vegetable tissue, serving to line an organ, connect parts, etc." Random House College Dictionary. Thus, a membrane, which is known to be pliable is inherent. Accordingly, by adding the modifier "flexible" Applicant was not adding new matter as the term inherently discloses the known characteristics of a membrane. Thus, the Examiner's rejection should be withdrawn.

2. The Prior Art Does Not Anticipate Under 35 U.S.C. § 102 By Disclosing Each Element and Limitation of the Claims

Claim 2 is rejected under 35 U.S.C. § 102(b) as being anticipated by Delanoy. Anticipation "requires that the same invention, including each element and limitation of the claims, was known or used by others before it was invented by the patentee." Hoover Group, Inc. v. Custom Metalcraft, Inc., 66 F.3d 299, 302, 36 U.S.P.Q.2d 1101, 1103 (Fed. Cir. 1995). "[P]rior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference." Elan Pharm., Inc. v. Mayo Foundation for Medical Educ. & Research, 304 F.2d 1221, 1227, 64 U.S.P.Q.2d 1292 (Fed. Cir. 2002) (citing *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950 (Fed. Cir. 1999); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 7 U.S.P.Q.2d 1057, 1064 (Fed. Cir. 1988)). "The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention."

Id. (citing Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1375, 62 U.S.P.Q.2d 1917, 1921 (Fed. Cir. 2002); In re Spada, 911 F.2d 705, 708 15 U.S.P.Q.2d 1655, 1657 (Fed. Cir. 1990)). See also PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2d 1618, 1624 (Fed. Cir. 1996) (emphasis added).

Claim 2 requires in part "[a] cap assembly threadably mounted on the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded onto the first end." In the written description, the Applicant has distinguished a cap 52 that screws onto threads 31 that are on the outside of

a pipe 34 with a cap 52 in an alternate embodiment that screws into interior threads of the pipe 34. (Pg. 4, lines 18-22). Thus, when claim 2 is read in light of the specification, it requires a cap threadably mounted on the exterior of the first end and not mounted in the interior of the first end. Delanoy teaches a cap 6 having an annular ring 7 having exterior threads that are mounted to the corresponding interior threads 3 of the pipe and not the exterior as is required by the claim when read in light of the specification. Therefore, because Delanoy does not teach each and every limitation set forth in claim 2 it does not anticipate and the Examiner's rejection should be withdrawn.

3. There is No Teaching or Suggestion to
Combine the Prior Art to Make Out a *Prima
Facie Case of Obviousness* Under 35 U.S.C. §
103

Claim 1 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball in view of Lewis. Applicant respectfully traverses.

An obviousness analysis begins in the text of section 103 with the phrase "at the time the invention was made." For it is this phrase that guards against entry into the "tempting but forbidden zone of hindsight when analyzing the patentability of claims pursuant to that section. See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 USPQ 90, 98 (Fed. Cir. 1985), overruled on other grounds by Nobelpharma AB v. Implant Innovations, Inc., 141 F.3d 1059, 46 USPQ 2d 1097 (Fed. Cir. 1998). Measuring a claimed invention against the standard established requires the often difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of

ordinary skill in the art, guided only by the prior art references and then-accepted wisdom in the field. See, e.g. W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against the teacher." Id.

The best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine] as an essential evidentiary component of an obviousness holding") combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. See, e.g. Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138, 277 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.") In this case, the Examiner has fallen into the hindsight trap.

Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem solved, although the suggestion more often comes from the teachings of the

pertinent references. Rouffet, 149 F.3d at 1355. The range of sources available does not diminish the requirement for actual evidence. That showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d at 1352. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. e.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statement, however, are not sufficient to establish a genuine issue of material fact.").

The obviousness rejection asserted by the Examiner is based on a combination of prior art references, e.g., the conventional overflow bathtub drain having a thin sealing membrane and a cap of Ball, combined with the horizontal leg that extends through overflow port and has a cap (constituted by capture nut 21) having cooperating threads. To justify this combination the Examiner simply stated "it would have been obvious to one of ordinary skill in the overflow system for a bathtub art, at the time the invention was made, to substitute for the screw attachment of the cap to the horizontal leg of Ball, the threaded attachment as, for example, taught by Lewis wherein doing so would amount to mere substitution of one attachment mechanism for another that would work equally well in the Ball device." (July 23, 2004 Office Action, page 4). Rather than pointing to specific information in Lewis that suggests the combination with Ball, the Examiner described the general functions of the threaded horizontal leg. Nowhere does the Examiner particularly identify any suggestion, teaching or motivation to combine the prior art references such as the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or

any other facts or findings that might serve to support a proper obviousness analysis. See e.g., Promold & Tool, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996).

To the contrary, the Examiner's decision is based on a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention and the broad conclusory statement that the substitution of the threaded attachment of Lewis would amount to mere substitution of one attachment for another. (Examiner's office action, pages 3-4). Yet this reference by reference, limitation by limitation analysis fails to demonstrate how the Lewis reference teaches or suggests its combination with Ball to yield the claimed invention.

Accordingly, because the Examiner has not particularly identified any suggestion, teaching or motivation to combine the prior art references, the Examiner's conclusion of obviousness as a matter of law, cannot stand.

4. The Combination of the Prior Art
References Does Not Lead to the Invention as
Claimed Under 35 U.S.C. § 103

Finally, Appellant has asserted that even if there was a suggestion or motivation to combine, the apparatus that would result still would not meet the limitations of claim 1. The teachings or suggestions to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicant's disclosure. See In re Vacck, 997 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); MPEP § 2143. To establish a *prima facie* case of obviousness, all the claim limitations must be taught by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). "All words in a claim must be considered in judging the

patentability of that claim against the prior art." In re Wilson, 57 C.C.P.A. 1029, 1032 (1970).

Claim 1 requires in part "a cap threadably mounted on an end of the horizontal leg extending through the overflow port; the cap having an opening in its circular planar end, with a thin flexible sealing membrane secured to the cap and extending over the opening in the circular planar end". The Examiner proposes that by substituting cap 70 that is secured to the horizontal leg by screws 78 in Ball, with the threadable capture nut 21 of Lewis, one can arrive at the claimed invention.

Here, the Examiner has relied upon hindsight to arrive at a determination of obviousness. It is well settled that a prior art reference is relevant for all that it teaches to those of ordinary skill in the art. Beckman Instruments Inc. v. LKB Produkter AB, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Lewis teaches the use of capture nut 21 to draw elbow 20 to tub 10 as shown in Fig. 3b. [¶ 0021]. It is the test plug 8 that is screwed down upon elbow 20 as shown and described in Figs. 3A and 3B that seal the end of the horizontal leg. [Id.] If the capture nut 21 is substituted alone, without plug 8, the proposed combination would not seal. Thus, the Examiner's proposed combination is based on a misapprehension of the scope of Lewis' teachings.

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The Federal Circuit has stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Here, the only way to arrive at the claimed invention through the combination of Ball and Lewis

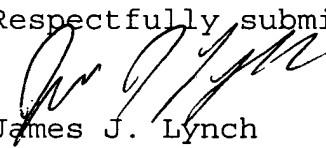
is by using the Applicant's claim as a guide. Therefore, the Examiner's rejection should be withdrawn.

Conclusion

Applicant therefore asserts that new matter has not been added to claim 1. Claim 2 is not anticipated by the prior art because each and every limitation of the claim has not been met. Additionally, the obviousness rejection to claim 1 should be withdrawn because the Examiner has not provided a motivation to combine the prior art references nor has each and every limitation of the combined references present without using the Applicant's application as a blueprint. Reversal is therefore respectfully requested.

A check in the amount of \$250 has been included with this appeal brief. All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,


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- JLH/bjs/jlk -

VIII. Claims Appendix

1. An overflow system for a bathtub which has a bottom, and adjacent side and endwalls, a drain port in the bottom, and an overflow port in one of the endwalls, comprising:
a drain pipe adapted to be in communication with said drain port and said overflow port,
said drain pipe having an inverted L-shape, including a horizontal leg extending into and through the overflow port of the bathtub, and a vertical leg extending downwardly for connection to a fluid drain system,
threads on the horizontal leg extending through the overflow port, and
a cap threadably mounted on an end of the horizontal leg extending through the overflow port,
the cap having an opening in its circular planar end, with a thin flexible sealing membrane secured to the cap and extending over the opening in the circular planar end.

2. A plumbing test system comprising;
a pipe having a first exposed end and second end in communication with a fluid source, wherein the first end comprises a threaded portion;
a cap assembly threadably mounted on the first end and wherein a portion of the cap assembly is composed of a material capable of sealing the first end when the cap is threaded onto the first end;
the cap assembly contains a cap having an opening in a planar end, with a sealing member secured to the cap and extending over the opening in the planar end.

IX. Evidence Appendix

None

X. Related Proceedings Appendix

None